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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,581	06/24/2003	Gary Balakoff	44904.000736	8202

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,581

Applicant(s)

BALAKOFF ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050314.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**WITHDRAWN REJECTIONS**

1. The 35 U.S.C. 112 rejections of claims 1-13 of record in the Office Action mailed December 14, 2004, Page 2 Paragraph 1, have been withdrawn due to Applicant's amendments in the Paper filed May 2, 2005.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitations that the first side is not an adhesive and does not have an adhesive coating applied thereto seems to be in conflict with the limitation that the first surface contains a tackifying resin, which suggests an adhesive. Therefore, it is not completely clear from the claim language and specification if the limitations are merely

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specifying that the first side is not a coating but instead a film, or if the limitations are requiring the first side to not be adhesive even though it adheres and comprises a tackifying resin. Although an actual amendment to the claim language may not be required for clarification a definitive explanation is required.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The 35 U.S.C. 103 rejections of claims 1-4 and 6-13 over Gotoh et al in view of Harvie are repeated for the reasons set forth in the previous Office Action mailed December 14, 2004, Pages 3-6 Paragraph 2. For better clarity with respect to the newly added limitations to claim 1 and new claims 14 and 15 the rejections are repeated below.

4. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh et al (USPN 5,286,781) in view of Harvie et al (USPN 5,693,405).

Gotoh et al teach a masking or surface protective film (col.1, 1.20-23) comprising a first side and second side. The limitations in the claim that the first said "is not an adhesive

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coating, and does not have an adhesive coating applied thereto" is interpreted in the broadest reasonable interpretation to limit the first side to not be an adhesive coating, yet can be an adhesive film and still read on the claim. In the specification page 7 paragraph 24, the Applicant specifically defines film and specifically differentiates coated films and co-extruded films. In this case the first side is a smooth surface film formed by co-extrusion and does not have an additional adhesive coating added to it. Therefore, Gotoh et al anticipate a smooth adhesive surface film that is not an adhesive coating as it is defined in the instant specification. The first side comprises hydrogenated styrene-isoprene-styrene block copolymer, which is styrene-ethylene/propylene-styrene, or hydrogenated styrene-butadiene-styrene, which is styrene-ethylene/butylene-styrene, or hydrogenated styrene-isoprene, which is styrene-ethylene/propylene, or hydrogenated styrene-butadiene, which is styrene-ethylene/butylene (col.3, 1.51-60). The first side further comprises 10-200 parts by weight per 100 parts by weight of the block copolymer of tackifying resin (col.4, 1.8-10) and 25-200 parts by weight per 100 parts by weight of the block copolymer of flexible polyolefins (col.4, 1.40-42). The flexible polyolefins are ethylene, polypropylene, or acrylate-modified polyethylenes (col.4, 1.17-24). The

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masking film comprises at least two co-extruded layers (col.5, 1.37-41). Regarding claims 14 and 15, specific examples of the proportions of the three components are shown in examples 3-5 with the hydrogenated SIS or SBS forming between 42% and 56% of the layer, and the tackifying resin forming between 28% and 43% of the layer (col.7, 1.45 - col.8, 1.18). Because the first side is formed from the same composition as the claimed invention and made by the same co-extrusion process and the properties of the same composition must be the same, the first side is inherently capable of removably adhering to a textured surface having a surface roughness in the range of from about 150 to 1000 Ra such as the surfaces claimed in claims 12 and 13.

Gotoh et al fail to explicitly teach forming the second side with a rough surface. However, Harvie et al teach the second side of a masking or surface protective film is matte embossed so that the film does not block on a roll or wrinkle during winding. The patterned embossed side of the film traps a quantity of air between wound layers of film as the film is being wound onto the roll. This air entrapment also facilitates the wrinkle-free unwinding of the film from the roll as it is being applied to a substrate (col.2, 1.24-30). Unembossed portions are applied to the second side to form a pattern decoration in order to provide brand identification and/or

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written marketing, instructional or advertising material without the need of time consuming and expensive printing techniques (col.1, 1.55-64). One of ordinary skill in the art would have recognized that the second side of a masking or surface protective film is matte embossed in a pattern with embossed and unembossed areas, so that the film does not block on a roll or wrinkle during winding and in order to provide brand identification and/or written marketing, instructional or advertising material without the need of expensive and time consuming printing processes, as taught by Harvie et al.

Regarding claim 10, Harvie teaches that one or more layers of the film include a pigment such that the matte portions appear different than the glossy unembossed portions, in order for ready visualization of the pattern (col.7, 1.3-12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to matte emboss the second side of the masking film of Gotoh et al, so that the film does not block on a roll or wrinkle during winding, the matte embossment is formed in a pattern of embossed and unembossed areas in order to provide brand identification and/or written marketing, instructional or advertising material without the need of expensive and time consuming printing processes, and one or more of the layers of

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the film include a pigment in order to improve visualization of the pattern, as taught by Harvie et al.

5. The 35 U.S.C. 103 rejection of claim 5 over Gotoh in view of Harvie and Okumura is repeated for the reasons set forth in the previous Office Action mailed December 14, 2004, Pages 6-7 Paragraph 3.

***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's arguments regarding the 35 U.S.C. 112 rejections of claims 1-13 of record have been considered but they are moot since the rejections have been withdrawn.

7. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-4 and 6-13 over Gotoh in view of Harvie have been fully considered but they are not persuasive.

In response to Applicant's argument that Gotoh teaches away from the claimed invention by disclosing a pressure sensitive adhesive coating composition, the following are two reasons Gotoh does not teach away from the claimed invention. First, the adhesive composition of Gotoh is co-extruded with other layers as a film. This is the same method used in the instant application for applying the adhesive film to other films and



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the instant specification on page 7 paragraph 24 specifically differentiates a co-extruded film from coated films. Therefore, because the adhesive composition of Gotoh is co-extruded to the other films the adhesive composition is defined as an adhesive film and not an adhesive coating as the terms are defined in the instant specification. Furthermore, the argument is made that the co-extrusion taught in Gotoh is still considered a coating because the adhesive composition is never taught standing alone and in some of the examples the film is much thinner than the base film. In response to this argument, there is no requirement in the claimed invention that the adhesive composition is not found in a multi-layered composite film and there is not mention of specific thickness values for the individual layers. Also, films are formed in a myriad of different thickness and are still considered films. Thickness in of itself is not a factor in determining whether a composition is forming a film or coating. Second, the claimed invention cannot specifically exclude the adhesive composition of Gotoh without specifically excluding the adhesive composition of the claimed invention because the composition is the same and it is formed into a layer by the same method.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes

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that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Harvie specifically teaches that patterned embossed material is formed on the side not used for adhering the masking film to an object in order to provide brand identification and/or written marketing, instructional or advertising materials without the need for expensive and time consuming printing processes (col.1, 1.55-64 and col.2, 1.56-61). Although Gotoh may not specifically require the embossed pattern for prevention of blocking and wrinkling and although brand identification and/or written marketing, instructional or advertising materials can be placed on smooth and rough surfaces, one of ordinary skill in the art would have recognized that the embossed patterns of Harvie would improve the masking film of Gotoh by providing the indicia without the expensive and technically more difficult printing processes. Therefore, one of ordinary skill in the art would have combined the teachings

of Gotoh and Harvie in order to improve the masking film of Gotoh for the reasons taught by Harvie.

8. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 5 over Gotoh in view of Harvie and Okumura have been fully considered but they are not persuasive.

In response to Applicant's argument that Gotoh and Harvie fail to render obvious claim 1 and therefore the addition of Okumura will fail to render claim 5 obvious, the reasons for why Gotoh and Harvie render claim 1 obvious are presented above.

#### **Conclusion**

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

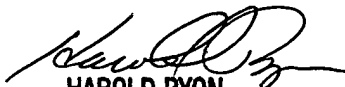
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Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB

June 30, 2005

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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6/30/05